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09/627,725	07/28/2000	Tomoko Oyabu	450100-02622	2836

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NEW YORK, NY 10151

EXAMINER
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HUYNH, SON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/627,725

**Applicant(s)**

OYABU ET AL.

**Examiner**

Son P Huynh

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-40 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the intelligent agent, in Maissel reference, monitors the viewing behavior of viewers and creates a preference profile based on the monitored viewing behavior. The viewer does not have the privilege of creating the electronic program guide on his/her own ....Maissel does not allow the user to remotely access the electronic program guide that the user has created...

In response to Applicant's argument, it is noted that the limitation above is not recited in the claims. Furthermore, Maissel discloses the interface unit 110 receives television broadcast from the television network. A user of the apparatus of figure 1 chooses a channel to watch, using means such as a remote control unit. The interface unit 110, responsive to the user's choice of channel, transmits display signals representing received broadcast on the chosen channel to the display apparatus 100 (par. 0153). In addition, a program schedule information is typically intended to assist a television viewer in choosing a television program to watch (par. 0155+). The intelligent agent also typically receives television viewing information representing current television viewing behavior of one of more individual viewer. The television viewing information typically

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comprising an indication of the channel currently being watched, viewer identification information... (par. 0170); and the apparatus is preferably operative to provide an appropriate questionnaire or other assisted data input method.... Particularly, the viewer is preferably enabled to provide information on programs or type of programs which the viewer prefers to view or prefers not to view (par. 0174+). Therefore, the program selection apparatus as claimed is met by the apparatus in figure 1, wherein the program selection information is met by the television viewing information or information on programs or types of program which the viewer prefers provided by viewer upon selection of one of said programs listed in the program schedule information or upon selection to respond to questionnaire respectively.

For reasons above, rejection for claims 1-40 are discussed as follow.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-8, 13-14, 25-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 7 recite the limitation "said remote commander" in lines 24-25.

Claim 13 recites the limitation "said remote commander" in lines 17, 19, 27, 29, 30-31.

There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 9-13, 17-19, 21-23, 25-27, 33-35, 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Maissel et al. (US 2003/0088872 A1).

Regarding claim 1, Maissel teaches a program guide information providing device (head end 340) adapted to communicate with a communication terminal device (interface 110); the program guide information providing device comprising:  
program guide information storing means (intelligent agent 330) for storing program guide information indicating the contents of programs to be supplied by predetermined program supplying means (see figure 8A and paragraphs 0218, 0245+);  
preference information storing means (profile storing unit 370-figure 8A) for storing preference information indicating the preferences of each of one or more users (par. 0244+), Maissel discloses the viewer preference profile associated with particular site

(par. 0244+), viewer identification may be received by interface unit (par. 0170+); and the program is transmitted to user using user's address (par. 0294). Inherently, the preference information for each user also corresponding to a particular communication terminal device (particular site) with identification associated therewith;

a receiver for receiving identification information from the communication terminal device indicative of the identification thereof (par. 0171+);

Maissel further discloses the intelligent agent is operative to customize the program schedule information received from the receiving unit 120 in accordance with one of more viewer preference profiles belonging to one or more viewers and to output a program guide comprising the customized program schedule information to the display apparatus for display (see paragraph 0184+). Clearly, the device comprises a searching means for reading from the preference information storing means the preference information; searching programs matching the preferences of the user from the program guide information based on the read preference information, and generating searched program guide information (customized program guide information) comprising the searched programs; and transmitting means for transmitting the searched program guide information to the communication terminal device. In addition, Maissel discloses a program selection apparatus (apparatus in figure 1 or figure 8) receives program selection information (television viewing information – par. 0170+ or information on programs or type of program which the viewer prefers to view – par. 0174, par. 0243+) upon selection of one of the program listed in the program guide information (program

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schedule information – par. 0155 or figures 9) by the user on the communication terminal device.

Regarding claim 2, Maissel discloses television programs (e.g. movies) is provided to terminal device by the headend (par.0245+, figure 8A). Inherently, the headend comprises a receiving means for receiving programs supplied from program supplying means.

Regarding claim 3, Maissel teaches a program guide information providing system comprising a communication terminal device (interface 110) and a program guide information providing device adapted to communicate with each other; wherein the program guide information providing device comprising limitations as discussed in the rejection of claim 1. Maissel further teaches the communication terminal device comprises: transmitting means (modem 375) for transmitting the guide information providing device (headend) the program identification information associated with the communication terminal device (viewer identification information, user's address or identification of particular site (par. 0170+ and figures 8A-B); receiving means (receive unit 120) for receiving the searched program guide information transmitted from the program guide providing device (figure 2); and notification means (display 100 –figure 1) for notifying the user of received searched program guide information; and transmitting means (modem 375 – par. 0243) for transmitting to a program selection apparatus program selection information (television viewing information – par. 0170+ or

information on programs or type of program which the viewer prefers to view – par. 0174, par. 0243+) upon selection of one of the program listed in the program guide information (program schedule information – par. 0155 or figures 9) by the user on the communication terminal device.

Regarding claim 4, Maissel discloses television programs (e.g. movies) is provided to terminal device by the headend (par.0245+, figure 8A). Inherently, the headend comprises a receiving means for receiving programs supplied from program supplying means.

Regarding claim 5, the limitations of the information receiving device as claimed correspond to the limitations of the information providing device in claim 1, and are analyzed as discussed with respect to the rejection of claim 1. In addition, Maissel teaches transmitting means for transmitting the searched program guide information to the remote commander (apparatus 10-figure 10) ; and a remote commander having first transmitting/receiving means (transmitter 101/receiver 40- figure 10B) for directly exchange information between the receiving means and the transmitting means, and second transmitting/receiving means (telephone network 80 or LAN 85) for exchanging information via the communication terminal device and the communicating means (figure 10 and par. 0294).



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Regarding claims 9-13, the limitations of the method as claimed correspond to the limitations of the device as claims in claims 1-5 respectively and are analyzed as discussed with respect to the rejection of claims 1-5.

Regarding claim 17, Maissel teaches the preference information storing means (370) is located adjacent to the program selection apparatus (360- figure 8A).

Regarding claim 18, Maissel teaches the preference information is located at a remote location (headend) apart from the program selection apparatus (interface unit 110 – figure 8A).

Regarding claim 19, Maissel teaches the preference information is retrieved over a public network (telephone network – par. 0243+).

Regarding claims 21-23, the limitations as claimed corresponding to the limitations as claimed in claims 17-19, and are analyzed as discussed with respect to the rejection of claims 17-19.

Regarding claims 25-27, the limitations as claimed corresponding to the limitations as claimed in claims 17-19, and are analyzed as discussed with respect to the rejection of claims 17-19.

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Regarding claims 33-35, the limitations as claimed corresponding to the limitations as claimed in claims 17-19, and are analyzed as discussed with respect to the rejection of claims 17-19.

Regarding claims 37-39, the limitations as claimed corresponding to the limitations as claimed in claims 17-19, and are analyzed as discussed with respect to the rejection of claims 17-19.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20, 24, 28, 36 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872).

Regarding claims 20, 24, 28, 36, Maissel teaches a device and method as discussed with respect to the rejection of claims 18, 22, 26, 34 and 38 respectively. Maissel further discloses the customized program guide could be delivered to a viewer by a personalized World Wide Web site on the Internet (par. 207-210). However, Maissel

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does not specifically disclose preference information is stored at a website. It would have been obvious to one of ordinary skill in the art that preference information is stored at a website in order to expand capabilities of the system.

8. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1), and in view of Ellis et al. (US 2003/0149988).

Regarding claim 6, Maissel teaches an information receiving device as discussed in the rejection of claim 5. However, Maissel does not specifically disclose recording control means for recording to recording means programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means.

Ellis teaches recording control means for recording to recording means (storage 15-see figures 2d, 4) programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means (see par. 0013). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching of Ellis in order to allow multiple users to share programs stored as the server and reduce space at the terminal device.

Regarding claim 14, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 6, and are analyzed as discussed with respect to the rejection of claim 6.

9. Claims 7, 15 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1) and in view of Darbee et al. (US 6,130,726).

Regarding claim 7, Maissel teaches an operating system wherein a communication terminal device (remote control 111) and an information receiving device (head end 15) are connected via predetermined communication (figure 10B) wherein the information receiving device comprising the limitations corresponding to the limitations of information receiving device as claimed in claim 5 and are analyzed as discussed with respect to the rejection of claim 5. Maissel further discloses each member of family of the user may select corresponding agent by using a different key on the remote control 111 or by using a different remote control (par. 0323), and user can choose a program. Inherently, the terminal device (remote control 111) comprises transmitting means for transmitting to the remote commander (apparatus 10) the identification information appropriate to the communication terminal device (remote command 111). In addition, Maissel discloses a program selection apparatus (apparatus in figure 1 or figure 8) receives program selection information (television viewing information – par. 0170+ or information on programs or type of program which the viewer prefers to view – par. 0174, par. 0243+) upon selection of one of the program listed in the program guide information (program schedule information – par. 0155 or figures 9) by the user using remote control unit. However, Maissel does not specifically disclose apparatus 10

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comprise a second transmitting means for exchanging information via remote control 111 and communicating means; the remote control 111 comprises: receiving means for receiving the searched program guide information transmitted from the apparatus 10, notifying means for notifying the user of the received searched program guide information; and program guide on the remote control.

Darbee discloses remote control that comprises transceiver 48 or (receiver 34/transmitter 35) for receiving program guide from a set top box and transmits command to the set top box (see figure 2 and col. 3, line 31+). The received program guide information is displayed the received program guide on LCD 14 (see figures 2, 5A). Thus, the remote commander (set top box) comprises a second transmitting means for transmitting program guide to the communication terminal device (remote control 10) and the communication terminal device comprises receiver 35 or transceiver 40 reads on the receiving means and the LCD 14 reads on the notification means. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching as taught by Darbee in order to allow user to search a program on the EPG without interrupting other viewers watching program on the screen of set top box.

Regarding claim 15, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 7, and are analyzed as discussed with respect to the rejection of claim 7.

Regarding claims 29-32, the limitations as claimed corresponding to the limitations as claimed in claims 17-20, and are analyzed as discussed with respect to the rejection of claims 17-20.

10. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1), in view of Darbee et al. (US 6,130,726); and further in view of Ellis et al. (US 2003/0149988).

Regarding claim 8, Maissel in view of Darbee teaches an information receiving device as discussed in the rejection of claim 7. However, neither Maissel nor Darbee specifically disclose recording control means for recording to recording means programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means.

Ellis teaches recording control means for recording to recording means (storage 15-see figures 2d, 4) programs specified by the communication terminal device from a plurality of programs supplied from the program supplied means (see par. 0013). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel and Darbee to use the teaching of Ellis in order to allow multiple users to share programs stored as the server and reduce space at the terminal device.

Regarding claim 16, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 8, and are analyzed as discussed with respect to the rejection of claim 8.

11. Claims 7, 15, 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (US 2003/0088872 A1) and in view of Croy et al. (US 6,040,829).

Regarding claim 7, Maissel teaches an operating system wherein a communication terminal device (remote control 111) and an information receiving device (head end 15) are connected via predetermined communication (figure 10B) wherein the information receiving device comprising the limitations corresponding to the limitations of information receiving device as claimed in claim 5 and are analyzed as discussed with respect to the rejection of claim 5. Maissel further discloses each member of family of the user may select corresponding agent by using a different key on the remote control 111 or by using a different remote control (par. 0323), and user can choose a program. Inherently, the terminal device (remote control 111) comprises transmitting means for transmitting to the remote commander (apparatus 10) the identification information appropriate to the communication terminal device (remote command 111). In addition, Maissel discloses a program selection apparatus (apparatus in figure 1 or figure 8) receives program selection information (television viewing information – par. 0170+ or information on programs or type of program which the viewer prefers to view – par.

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0174, par. 0243+) upon selection of one of the program listed in the program guide information (program schedule information – par. 0155 or figures 9) by the user using remote control unit. However, Maissel does not specifically disclose apparatus 10 comprise a second transmitting means for exchanging information via remote control 111 and communicating means; the remote control 111 comprises: receiving means for receiving program guide information transmitted from the apparatus 10, notifying means for notifying the user of the received searched program guide information; and program guide on the remote control.

Croy discloses a communication terminal device (remote device 200) comprising: transmitting means (210 – figure 2 and col. 5, line 4+) for transmitting to the remote commander (base station 100- figure 1) the identification information associated with the communication terminal device (col. 6, line 1+); receiving means (210 – figure 2 and col. 5, line 4+) for program guide transmitted from the base station 100; notifying means (LCD 240 – figure 2 and col. 5, line 25+) for notifying the user of the received program guide information; and transmitting means for transmitting to a program selection apparatus (base station 100 or provider – col. 5, line 57+) program selection information upon selection of one of the program lists in the program guide information by a user on the communication terminal device (remote device 200- col. 6, line 1+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Maissel to use the teaching



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as taught by Croy in order to allow user to navigate EPG without interrupting other viewers watching program on the screen of set top box.

Regarding claim 15, the limitations of the method as claimed correspond to the limitations of the device as claims in claim 7, and are analyzed as discussed with respect to the rejection of claim 7.

Regarding claims 29-32, the limitations as claimed corresponding to the limitations as claimed in claims 17-20, and are analyzed as discussed with respect to the rejection of claims 17-20.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Croy et al. (US 6,476,825) teaches handheld video viewer and remote control device.

Lang et al. (US 5,983,214) teaches system and method employing individual user content based data and user collaborative feedback data to evaluate the content of and information.

Huang et al. (US 6,437,836) teaches extended functionally remote control system and method thereof.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh  
April 8, 2004



**VIVEK SRIVASTAVA**  
**PRIMARY EXAMINER**